

**REMARKS**

Claims 1-58 remain pending in the application.

The Applicant respectfully requests that the Examiner reconsider earlier rejections in light of the following remarks. No new issues are raised nor is further search required as a result of the changes made herein. Entry of the Amendment is respectfully requested.

**Claims 1, 4-21 and 24-58 over Matsumoto in view of Kanevsky**

Claims 1, 4-21 and 24-58 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,678,720 to Matsumoto ("Matsumoto") in view of U.S. Patent Application Publication No. 2002/0069069 to Kanevsky et al. ("Kanevsky"). The Applicant respectfully traverses the rejection.

Claims 1, 4-20 and 53-58 recite a system and method initiating a transfer of an instant message and a chat history in a first data format compatible with a first real-time chat system, and transferring the instant message and the chat history in a second data format compatible with a second real-time chat system. Claims 21 and 24-52 recite a system and method to convert an instant message and a chat history from a first data format that is compatible with a first real-time chat system to a second data format that is compatible with a second real-time chat system.

The Examiner again acknowledged that Matsumoto does not disclose a second system that is a real time instant messaging system (see Response to Arguments section of the Office Action, page 20). However, the Examiner alleged that Matsumoto discloses voicemail at col. 2, line 64 that can be heard in real-time and is generally part of a chat system like a phone (see Response to Arguments section of the Office Action, page 20). The Applicants respectfully disagree.

Matsumoto fails to disclose voicemail of any kind. Matsumoto discloses at col. 2, line 64, and throughout the disclosure, the use of voice data. Moreover, even if the Examiner were to equate Matsumoto's voice data to

voicemail, without support in Matsumoto, Matsumoto's second information terminal is disclosed as being an ordinary information terminal, i.e., a telephone set or fax machine on a telephone circuit network, or a PC independent of the Internet (see col. 2, lines 57-59). Matsumoto discloses text data is converted to voice data for review on a telephone (see col. 10, lines 12-21). However, Matsumoto fails to disclose or suggest conversion of a user's voice data into a text message for participation in a chat. Matsumoto at col. 2, line 64 fails to disclose a second real-time chat system, much less transferring an instant message and a chat history in a second data format compatible with a second real-time chat system, as recited by claims 1, 4-21 and 24-58.

Moreover, since Matsumoto's second information terminal is disclosed as being an "ordinary information terminal", i.e., a telephone set or fax machine on a telephone circuit network, or a PC independent of the Internet (see col. 2, lines 57-59) that LACKS real-time chat capability, Matsumoto actually TEACHES AWAY from use of a second real-time chat system. Matsumoto's invention is directed toward allowing persons that DO NOT have access to a real-time chat system to MONITOR a chat for its content using a phone or fax. Thus, Matsumoto's invention TEACHES AWAY from participating in an instant messaging chat through use of a second real-time chat system since Matsumoto's second real-time chat system is an "ordinary information terminal". A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02, page 2100-127 (Rev. 2, May 2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

Moreover, the Examiner alleged that a phone is part of a chat system. However, Applicant's claims are directed toward an instant message compatible with a real-time chat system. Thus, a reading of the entire claim limitation reveals that the claimed features do not read on the prior art's use of a that a phone that is only used to monitor a chat NOT having instant messaging and real-time chat capability.

Moreover, the Examiner has failed to address much less refute the Applicant's previous argument that the reason that Matsumoto fails to disclose a second system that is a real time instant messaging system is that Matsumoto's second system has nothing to do with instant messaging, as the Examiner acknowledged. Matsumoto discloses a conversion means that converts a message history, which is text data, to voice data, plays back the voice and sends it to a telephone set and alternately converts the message history to image data to be sent to a fax machine (See Matsumoto, col. 4, lines 60-62; col. 4, lines 62-64). Thus, "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). NOTHING within Matsumoto nor Kanevsky suggests the Examiner's modification of Matsumoto's telephone set or fax machine to instead be an instant messaging real-time chat system, as recited by claims 1, 4-21 and 24-58. Applicant traverses the Official Action as incomplete because it fails to answer the material traversed. (See MPEP §707.07(f) "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."). If the Examiner issues comments to refute the fact that nothing within the cited prior art suggests modifying Matsumoto, the Applicant respectfully requests the Finality of the Office Action be withdrawn to allow the Applicant an opportunity to respond to any further comments from the Examiner.

The Examiner alleges that Kanevsky is relied on "because it enforces the idea that conversion between chat systems is unpatentable as claimed." Thus, the Examiner acknowledged that the Examiner is not examining the specifics of the claims, but broad concepts. It is well settled that each and every claim limitation must be considered. As specified in MPEP §2143.03, entitled "All Claim Limitations Must Be Taught or Suggested": "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that

claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." MPEP §2143.03 at 2100-133 (Rev. 2, May 2004). The Examiner acknowledged that the Examiner is not considering each and every claim limitation and all words within the claims. Thus, the Applicant respectfully requests that the rejection be withdrawn as improper.

Moreover, as previously argued to the Examiner and the Examiner has failed to address much less refute is that the Examiner's motivation for modifying Matsumoto with the disclosure of Kanevsky "to connect disparate chat service systems (Kanevsky, col. 1, lines 11; last line)" is **nonsensical** (See Office Action, page 3). The Examiner's motivation is why Kanevsky came up with his invention **NOT** a reason to modify Matsumoto. Modifying Matsumoto, that fails to disclose a second chat service, i.e., instead disclosing a fax machine and a telephone, would **NOT** benefit from connection of disparate chat service systems, i.e., a first chat service and a second chat service. Applicant traverses the Official Action as incomplete because it fails to answer the material traversed. (See MPEP §707.07(f) "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."). If the Examiner issues comments to refute the fact that modifying Matsumoto to connect disparate chat service systems is **nonsensical**, the Applicant respectfully requests the Finality of the Office Action be withdrawn to allow the Applicant an opportunity to respond to any further comments from the Examiner.

Moreover, Kanevsky appears to disclose a system and method for real time teleconferencing, where one of the participants is deaf or hearing-impaired (See Abstract). An Integration Server receives all of the participant's chat messages, which have various formats, and translates them into a format used by the chat service system of the deaf or hearing-impaired participant (See Kanevsky, Abstract). Thus, Kanevsky appears to disclose conversion of a message from a first chat system to a second chat system. However, Kanevsky fails to disclose or suggest conversion of an instant message AND a chat history. Thus, neither Matsumoto nor Kanevsky disclose or suggest conversion of an

instant message AND a chat history between TWO **real-time** systems, as recited by claims 1, 4-21 and 24-58.

The Examiner alleged that Kanevsky discloses both instant messages and chat histories, with chat histories being used when a transcript of a message is received and interpreted by the system from the ASR and when the system translates the transcript of two other people's conversation for someone's chat service system at paragraph 11. The Applicants respectfully disagree.

Kanevsky at paragraph 11 simply discloses a system that allows deaf persons to participate in real time teleconferencing. For the deaf, text chat services are employed to allow a user to view audio produced by a non-deaf participant in the teleconference (see Kanevsky, paragraph 11, lines 3-7). The transcription that the Examiner refers to is a text from a real-time conversation occurring within the teleconference, similar to real-time messages flowing within a conventional instant messaging chat system. Kanevsky at paragraph 11, nor anywhere else within the disclosure, discloses or suggest conversion of an instant message AND a chat history between TWO **real-time** systems, as recited by claims 1, 4-21 and 24-58.

Thus, Matsumoto theoretically modified by the disclosure of Kanevsky would at best suggest conversion of a message history to voice for a telephone set or an image for a fax machine (Matsumoto) and conversion of a chat message to a chat service system for a deaf or hearing-impaired participant (Kanevsky). Matsumoto modified by the disclosure of Kanevsky fails to disclose or suggest an instant message AND a chat history between TWO **real-time** systems, as recited by claims 1, 4-21 and 24-58.

A benefit of converting an instant message and a chat history from a first data format that is compatible with a first **real-time** messaging system to a second data format that is compatible with a second **real-time** chat system and transferring an instant message and a chat history in a second data format compatible with a second **real-time** chat system is, e.g., the ability to enter a chat between incompatible **real-time** systems more completely. Conventionally, there are numerous incompatible real-time chat systems that allow users to send

messages amongst their individual subscribers. However, a user cannot enter a chat between incompatible real-time chat system without knowing a context of an ongoing chat which requires a chat history. A system and method of converting an instant message and chat history facilitates a user of incompatible system to enter an ongoing chat and understand the context of the ongoing conversation. The cited prior art fails to disclose or suggest the claimed features having such benefits.

Accordingly, for at least all the above reasons, claims 1, 4-21 and 24-58 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

**Claims 2, 3, 22 and 23 over Matsumoto in view of Kanevsky and Scott**

Claims 2, 3, 22 and 23 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Matsumoto in view of Kanevsky, and further in view of U.S. Application Publication No. 2001/0044820 to Scott ("Scott"). The Applicant respectfully traverses the rejection.

Claims 2, 3, 22 and 23 are dependent on claims 1 and 21 respectively, and are allowable for at least the same reasons as claims 1 and 21.

Claims 2 and 3 recite a method of initiating a transfer of an instant message and a chat history in a first data format compatible with a first **real-time chat** system, and transferring the instant message and the chat history in a second data format compatible with a **second real-time chat** system. Claims 22 and 23 recite a system to convert an instant message and a chat history from a first data format that is compatible with a first **real-time chat** system to a second data format that is compatible with a **second real-time chat** system.

As discussed above, Matsumoto in view of Kanevsky fails to disclose or suggest conversion of an instant message AND a chat history between TWO **real-time** systems, as recited by claims 2, 3, 22 and 23.

Scott was relied on to disclose indicating an unavailability in response to a non-establishment of a communication channel (See Office Action, page 15). Scott's invention is directed toward monitoring and detecting static,

dynamic and active web content (Abstract). However, Scott fails to disclose or **suggest** disclose or suggest conversion of an **instant message** **AND** a **chat history** between TWO **real-time** systems, as recited by claims 2, 3, 22 and 23.

Thus, even if it were obvious to modify Matsumoto with the disclosure of Kanevsky and Scott (which it is not since the three inventions are addressing completely different problems within their respective arts), the theoretically modified Matsumoto would fail to disclose or disclose or suggest conversion of an **instant message** **AND** a **chat history** between two **real-time chat** systems, as recited by claims 2, 3, 22 and 23.

Accordingly, for at least all the above reasons, claims 2, 3, 22 and 23 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

### **Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

 (46,504) for

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